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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/520,159	03/07/00	AHN	S AHH003.UPA

QM12/0918

ALFRED F HOYTE ESQ
131 E BROAD STREET SUITE 206
FALLS CHURCH VA 22046

EXAMINER

PASSANITI, S

ART UNIT	PAPER NUMBER
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3711

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DATE MAILED:

09/18/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/520,159

Applicant(s)

AHN

Examiner
SEBASTIANO PASSANITI

Group Art Unit
3711



☒ Responsive to communication(s) filed on May 31, 2000

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) 1-6 is/are pending in the application

Of the above, claim(s) _____ is/are withdrawn from consideration

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-6 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

Sebastiano Passaniti
Primary Examiner

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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This Office action is responsive to communication received 05/31/00 - preliminary amendment A.

At the outset, it is noted that the amendment received 05/31/00 contains directions to amend the specification, abstract and claims of the originally filed application.. The amendment also contains what appears to be a substitute specification. The substitute specification filed has not been entered because it does not conform to 37 CFR 1.125(b)because: a marked up copy has not been included.

In an effort to advance the rules of compact prosecution for patent applications, it is noted that the amendments submitted with the letter of 05/31/00 have been entered as the changes relate to the original disclosure. In other words, the originally filed papers of 03/07/00 have been amended as per the changes requested by the preliminary amendment of 05/31/00. If these are the only changes that the applicant desires to have considered and entered, a further, revised substitute specification would not appear to be necessary. Should applicant desire to voluntarily file a substitute specification to advance prosecution regarding other details of the invention, note 37 CFR 1.125(b).

Claims 1-6 are pending.

Following is an action on the MERITS:

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The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 and 4 are rejected under 35 U.S.C. 102(b) as being anticipated by Antonious.

The patent to Antonious includes a raised spherical portion (18) having substantially the same size and shape as a golf ball to serve as a visual alignment arrangement. Hence, the marking formed by the raised portion must inherently contain a radius that is of a curvature which is a function of a distance from an approximate center point of a golf ball to the striking face when the golf ball is abutted against the striking face. The top surface of the Antonious patent is delineated by a border, that is, the club head is contoured. Note that "contoured" does not necessarily imply a curved surface.

Claims 1, 5 and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by White.

Note the marking on the top surface comprising half-sphere (32) and lines (34, 35). The lines may be inscribed or otherwise painted in the top surface. Figures 2 and 3 show a natural color contrast between the lines and the half-sphere as well as between the half-sphere and the remainder of the clubhead. Hence, the marking formed by the raised portion must inherently contain a radius that is of a curvature which is a function of a distance from an approximate center point of a golf ball to the striking face when the golf ball is abutted against the striking face. The

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top surface of the White patent is delineated by a border, that is, the club head is contoured.

Again, note that "contoured" does not necessarily imply a curved surface.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2 and 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over White.

Although White does not specifically state that the arc of the circle represented by the half-sphere is scored within the top surface, it would have been obvious to provide this marking to the top surface of the head via a scoring method, paint routine, inclusion of a raised border or through any other common expedient in order to distinguish the marking from the remainder of the head. In fact, White plainly suggests that the lines (34, 35) may be provided via an inlay process or by simply painting the lines on the head surface.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

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A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-6 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5 of U.S. Patent No. 6,045,452 to Ahn in view of Antonious, White and Bianco. The claims of the Ahn patent differ from the claimed invention in that the claims to Ahn do not require the radius configuration of the marking as well as any of the painted, raised portion, or scored limitations for the marking. Each of White, Antonious and Bianco show it to be old in the art to provide indicia on the top surface of a club, said indicia being sized with respect to the dimensions of a regulation golf ball in order to help a golfer maintain a proper alignment between the face of the club and the ball at address. Each prior art reference teaches at least one of various methods for providing said indicia, with White describing a scoring or paint procedure for the markings (34, 35), Antonious disclosing a raised portion (18), and Bianco extolling the benefits of either an engraving method or otherwise permanent process as well as the use of an adhesive decal. In view of the patents to White, Antonious, and Bianco, it would have been obvious to modify the claimed device in the Ahn patent by including a curved portion having a radius of curvature related to the radius of a golf

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ball, the purpose being to enable a golfer to more accurately align the golf ball with the striking face. To have further modified the claimed device of the Ahn patent to include the required paint, raised portion or scored markings would have been obvious, the motivation being to enable one to simply and clearly distinguish the markings from the remainder of the head.

Enclosed with this Office action is a sample terminal disclaimer which is effective to overcome an obviousness-type double patenting rejection over a prior patent (37 CFR 1.321(b) and (c)).

Also enclosed is a sample Certificate Under 37 CFR 3.73(b) which an assignee may use in order to ensure compliance with the rule. Part A of the Certificate is used when there is a single assignment from the inventor(s). Part B of the Certificate is used when there is a chain of title. The "Copies of assignments..." box should be checked when the assignment document(s) (set forth in part A or part B) is/are not recorded in the Office, and a copy of the assignment document(s) is/are attached. When the "Copies of assignments..." box is checked, either the part A box or the part B box, as appropriate, must be checked, and the "Reel____, Frame____" entries should be left blank. If the part B box is checked, and copies of assignments are not included, the "From:_____ To:_____" blank(s) must be filled in. This certificate should be used the first time an assignee seeks to take action in an application under 37 CFR 3.73(b), e.g., when signing a terminal disclaimer or a power of attorney.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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Claims 1-6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As to claims 1-6 in general, the preamble to claim 1 recites "for putting a golf ball" conveying that the golf ball is recited as part of a statement of intended use. However, the body of the claim recites "said golf ball" implying that the golf ball is to be positively recited as an element in the claim. This is rather confusing, as it can not be determined if the invention is directed to the golf putter per se, or the combination of the putter and the golf ball. If the former situation holds, the claims should be clear in reciting all occurrences of the golf ball in a functional light. If the latter interpretation holds true, then the claims should clearly recite the combination of a putter and a golf ball.

As to claims 2-5, these claims depend from claim 1 and, accordingly, are deemed to be indefinite.

As to claim 6, is the concentric circle in line 3 intended to describe the shape or dimension of a cross-section of a golf ball? In other words, does the curved portion have a radius of curvature which is an arc of a concentric circle that is of the same dimension as the cross-section of a golf ball ?

The drawings filed 05/31/00 are acceptable.

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All references cited during prosecution of the parent application serial number 09/114,523 are deemed pertinent to this application and are incorporated herein by reference. Copies of these references, with the exception of those cited within the text of this Office action, are not being furnished to the applicant, but have been cited on the attached FORM - PTO 892. See MPEP §707.05(a).


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sebastiano Passaniti whose telephone number is (703)308-1006.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeanette Chapman, can be reached on (703) 308-1310. The formal fax phone number for the organization where this application or proceeding is assigned is (703) 305-3579. The informal fax phone number is (703) 308-7768. Applicant is strongly urged to contact or leave voice mail notification with the examiner just prior to sending an informal facsimile transmission.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.

Applicant may find it useful to refer to the Official Web site for the United States Patent & Trademark Office at **www.uspto.gov** for information regarding a variety of patent and trademark related topics.

Sebastiano Passaniti/ sp
September 14, 2000


SEBASTIANO PASSANITI
PRIMARY EXAMINER
ART UNIT 3711

PTO/SB/26 (10-96)
 Approved for use through 10/31/99. OMB 0651-0031
 Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

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TERMINAL DISCLAIMER TO OBVIATE A DOUBLE PATENTING REJECTION OVER A PRIOR PATENT	Docket Number (Optional)
<p>In re Application of: Application No. Filed: For:</p> <p>The owner*, of percent interest in the instant application hereby disclaims, except as provided below, the terminal part of the statutory term of any patent granted on the instant application, which would extend beyond the expiration date of the full statutory term defined in 35 U.S.C. 154 to 156 and 173, as presently shortened by any terminal disclaimer, of prior Patent No. The owner hereby agrees that any patent so granted on the instant application shall be enforceable only for and during such period that it and the prior patent are commonly owned. This agreement runs with any patent granted on the instant application and is binding upon the grantee, its successors or assigns.</p> <p>In making the above disclaimer, the owner does not disclaim the terminal part of any patent granted on the instant application that would extend to the expiration date of the full statutory term as defined in 35 U.S.C. 154 to 156 and 173 of the prior patent, as presently shortened by any terminal disclaimer, in the event that it later expires for failure to pay a maintenance fee, is held unenforceable, is found invalid by a court of competent jurisdiction, is statutorily disclaimed in whole or terminally disclaimed under 37 CFR 1.321, has all claims cancelled by a reexamination certificate, is reissued, or is in any manner terminated prior to the expiration of its full statutory term as presently shortened by any terminal disclaimer.</p> <p>Check either box 1 or 2 below, if appropriate.</p> <p>1. <input type="checkbox"/> For submissions on behalf of an organization (e.g., corporation, partnership, university, government agency, etc.), the undersigned is empowered to act on behalf of the organization.</p> <p>I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.</p> <p>2. <input type="checkbox"/> The undersigned is an attorney of record.</p> <div style="text-align: right; margin-top: 20px;"> <div style="display: inline-block; width: 40%; border-bottom: 1px solid black; margin-bottom: 5px;"></div> <div style="display: inline-block; width: 40%; border-bottom: 1px solid black; margin-bottom: 5px;"></div> <div style="display: inline-block; width: 20%;"></div> </div> <div style="text-align: center; margin-top: 5px;"> Signature Date </div> <div style="text-align: center; margin-top: 10px;"> <div style="border-bottom: 1px solid black; width: 100%;"></div> Typed or printed name </div> <p><input type="checkbox"/> Terminal disclaimer fee under 37 CFR 1.20(d) included.</p> <p><small>*Certification under 37 CFR 3.73(b) is required if terminal disclaimer is signed by the assignee (owner). Form PTO/SB/96 may be used for making this certification. See MPEP § 324.</small></p>	

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CERTIFICATE UNDER 37 C.F.R. § 3.73(b)

Applicant: _____

Application No.: _____ Filed: _____

For: _____

_____, a _____,
(Name of Assignee) (Type of Assignee, e.g., corporation, partnership, university, government agency, etc.)

certifies that it is the assignee of the entire right, title and interest in the patent application identified above by virtue of either:

A. ☐ An assignment from the inventor(s) of the patent application identified above. The assignment was recorded in the Patent and Trademark Office at Reel _____, Frame _____, or for which a copy thereof is attached.

OR

B. ☐ A chain of title from the inventor(s), of the patent application identified above, to the current assignee as shown below:

1. From: _____ To: _____
The document was recorded in the Patent and Trademark Office at
Reel _____, Frame _____, or for which a copy thereof is attached.

2. From: _____ To: _____
The document was recorded in the Patent and Trademark Office at
Reel _____, Frame _____, or for which a copy thereof is attached.

3. From: _____ To: _____
The document was recorded in the Patent and Trademark Office at
Reel _____, Frame _____, or for which a copy thereof is attached.

☐ Additional documents in the chain of title are listed on a supplemental sheet.

☐ Copies of assignments or other documents in the chain of title are attached.

The undersigned has reviewed all the documents in the chain of title of the patent application identified above and, to the best of undersigned's knowledge and belief, title is in the assignee identified above.

The undersigned (whose title is supplied below) is empowered to act on behalf of the assignee.

I hereby declare that all statements made herein of my own knowledge are true, and that all statements made on information and belief are believed to be true; and further, that these statements are made with the knowledge that willful false statements, and the like so made, are punishable by fine or imprisonment, or both, under Section 1001, Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

Date : _____

Name : _____

Title : _____

Signature: _____